

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.03 (8<sup>th</sup> Ed., Rev. 1, Feb. 2003), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8<sup>th</sup> Ed., Rev. 1, Feb. 2003).

#### **I. Claims 1, 9, 17 and 25**

Claims 1 and 17 recite "determining whether register data corresponding to a selected thread has changed from a previous interrupt of all of the threads." Claims 9 and 25 contain similar language. The Examiner asserts that Jackson teaches such recitations. See *Office Action*, ¶ 6 (citing Jackson, abstract and col. 3, lines 33-54). However, contrary to the Examiner's assertions, Jackson does not teach such a determination, either in the cited portions thereof or anywhere else.

Although Jackson examines and stores "the current state of the selected application, including its location counter," (col. 2, lines 22-24) and "analyze[s] the current state of the registers within application 30 [to] determine where execution is taking place" (col. 3, ll. 48-49), this does not equate to a determination as to whether the register data corresponding to a selected thread has changed from a previous interrupt.

Instead, Jackson determines where execution is taking place by examining the current location counter (col. 2, lines 20-27), without regard to whether the register data corresponding to a selected thread has changed from a previous interrupt. Accordingly, for at least these reasons, Jackson fails to teach or suggest each and every recitation of claims 1, 9, 17 and 25 and Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 2-4, 10-12, 18-20, 26, 27, 30 and 31 depend from one of claims 1, 9 and 17. As explained, claims 1, 9 and 17 are distinguished from Jackson. Thus, claims 2-4, 10-12, 18-20, 26, 27, 30 and 31 are also distinguishable from Jackson for at least the same reasons set forth for claims 1, 9 and 17. Accordingly, Applicant respectfully requests that the rejection of claims 2-4, 10-12, 18-20, 26, 27, 30 and 31 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Further, the Examiner admits that Jackson does not teach “comparing the stored data with register information stored following a previous interrupt,” as recited in claim 2. Instead, Jackson examines the current location counter (col. 2, lines 20-27), without making any such comparison. The Examiner neither cites a reference nor takes official notice to supply the missing teaching. Nevertheless, the Examiner asserts that it would have been obvious to modify Jackson to make such a comparison “in order to provide means for efficiently identifying areas of the application program requiring excessive execution time.” This is error: “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03 (8<sup>th</sup> Ed., Rev. 1, Feb. 2003). Accordingly, Applicants respectfully

request that the Examiner either cite a competent prior art reference to substantiate the conclusion of obviousness, or else withdraw the rejection of claim 2.

Moreover, the Examiner asserts that Jackson teaches "computing a value corresponding to the stored data; and determining a relationship between the computed value and the previously stored register information," as recited in claim 3. See *Office Action*, ¶ 8 (citing Jackson, col. 2, ll. 8-30, and col. 3, ll. 45-54). However, Applicants can find no teaching of such computation in Jackson, either in the cited portions thereof or anywhere else. Accordingly, the Examiner's assertions are unsupported by the art relied upon, and Applicant respectfully requests that the rejection of claim 3 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

Because Jackson does not make a determination as to whether a computed value matches previously stored register information, Jackson does not teach or suggest updating a memory segment to reflect that the selected thread is running when it is determined that the computed value and the previously stored register value do not match, as recited in claim 4. Therefore, Applicant respectfully requests that the rejection of this claim under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

## **II. Claims 5, 13, and 21**

Claims 5, 13 and 21 include recitations similar to those cited with respect to claim 3. As explained, claim 3 is distinguished from Jackson. Accordingly, claims 5, 13 and 21 are also distinguished from Jackson for at least the same reasons set forth for claim

3, and Applicant respectfully requests that the rejection of claims 5, 13 and 21 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 6, 14, 15, 22, 28 and 32 depend from one of claims 5, 13 and 21. As explained, claims 5, 13 and 21 are distinguished from Jackson. Accordingly, claims 6, 14, 15, 22, 28 and 32 are likewise distinguished from Jackson for at least the same reasons set forth above in connection with claims 5, 13 and 21. Further, claim 6 includes recitations similar to claim 4. As explained, claim 4 is distinguishable from Jackson. Therefore, claim 6 is also distinguished from this reference for at least the same reasons set forth above with respect to claim 4. Accordingly, Applicant respectfully requests that the rejection of claims 6, 14, 15, 22, 28 and 32 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

### **III. Claims 8, 16, and 24**

Claims 8, 16 and 24 include recitations similar to those cited above in connection with claim 2. As explained, claim 2 is distinguished from Jackson. Therefore, claims 8, 16 and 24 are also distinguished from Jackson for at least the same reasons set forth with respect to claim 2. Accordingly, Applicant respectfully requests that the rejection of claims 8, 16 and 24 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 29 and 33 depend from claims 8 and 24, respectively. As explained, claims 8 and 24 are distinguished from Jackson. Accordingly, claims 29 and 33 are also distinguished from Jackson for at least the same reasons set forth above with

respect to claims 8 and 24, and Applicant respectfully requests that the rejection of claims 29 and 33 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

**Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of claims 1-6, 8-22 and 24-33.

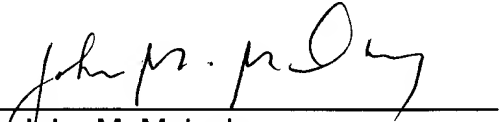
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 15, 2004

By: \_\_\_\_\_

  
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